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NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER ABDI, KAMBIZ	
			ART UNIT 3621	PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/617,760	STEFIK ET AL.	
	Examiner	Art Unit	
	Kambiz Abdi	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>14 July 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 70-119 have been examined.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Claim Objections

3. Claims 88 and 89 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It seems that the numbering of the claims is inaccurate.
4. Claims 90 and 91 are dependent claims 88 and 89 that are objected to above. Clarification is requested.

Double Patenting

5. Claims 70-86 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 9-11, 12-18, and 19-31 of U.S. Patent No. 5,629,980 to Mark J. Stefik et al.
6. As for claim 1 of U.S. Patent No. 5,629,980 recites:
 - A system for secure distribution and control of digital works between repositories comprising:
 - means for creating usage rights, each instance of a usage right representing a specific instance of how a digital work may be used or distributed;
 - means for attaching a created set of usage rights to a digital work;
 - a communication medium for coupling repositories to enable exchange of repository transaction messages;
 - a plurality of general repositories for storing and securely exchanging digital works with attached usage rights, each of said general repositories comprising:
 - a storage means for storing digital works and their attached usage rights;

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- an identification certificate for indicating that the associated general repository is secure;
- an external interface for removably coupling to said communications medium;
- a session initiation transaction processing means for establishing a secure and trusted session with another repository, said session initiation transaction processing means using said identification certificate;
- a usage transaction processing means having a requester mode of operation for generating usage repository transaction messages to request access to digital works stored in another general repository, said usage repository transaction message specifying a usage right, said usage transaction processing means further having a server mode of operation for determining if a request for access to a digital work stored in said storage means may be granted, said request being granted only if the usage right specified in said request is attached to said digital work; and
- an input means coupled to said usage transaction processing means for enabling user created signals to cause generation of a usage repository transaction message to request access to digital works.

7. Claims 1, 9, 12, and 19 of U.S. Patent No. 5,629,980 differs since they recite additional limitations as stated in the claims, but it clearly includes the current applications claimed limitations of claim 70-86 as well. These limitations include the requesting steps, determination step, and granting step and associated processing system and usage rights specifications. However, it would have been obvious to a person of ordinary skill in the art to modify any of the claims 1, 9, 12, or 19 of U.S. Patent No. 5,629,980 by removing certain limitations directed to the elements that make up a system resulting in a claim such as claims 70 and 87 of current application, since both claims actually perform the same function. It is well established that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

8. As for claims 71-86, the same rational as above exists. Even though the language of the claims are different the essence of invention claimed in the claims are the same and they deemed to be the same as claims 1-31.

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9. It should be noted that the same double patenting obviousness argument as above is made based on the same rational as stated above for U.S. Patent No. 6,708,157, titled "SYSTEM FOR CONTROLLING THE DISTRIBUTION AND USE OF DIGITAL WORKS USING DIGITAL TICKETS".

10. Claim 70-86 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,708,157 to Mark J. Stefik et al.

11. As for claim 1 of U.S. Patent No. 6,708,157 recites:

A system for controlling the distribution and use of digital works comprising:

- means for associating one or more usage rights with a digital work,
- said one or more usage rights specifying a manner of use indicating a particular manner of how said digital work may be used and at least one condition that must be satisfied in order to exercise the manner of use,
- at least one of said usage rights specifying a digital ticket, the possession of said digital ticket being a condition for that usage right;
- a plurality of repositories for storing and exchanging digital works, each of said plurality of repositories comprising:
 - storage means for storing digital works, their associated usage rights, and digital tickets;
 - transaction processing means having a requester mode of operation for requesting access to a digital work,
- said request specifying a usage right, and
- a server mode of operation for processing requests to access said requested digital work based on said usage right specified in said request, the usage rights associated with said digital work, and digital tickets associated with said usage rights;
- a generic ticket agent for punching digital tickets to indicate that an associated usage right has been exercised in accordance with a manner of use specified by the usage right;

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- a granting means for granting access to said digital work in accordance with the manner of use specified by said usage right if the requester possesses the digital ticket, wherein said granting means is not only a Boolean operator for filtering; and
- a coupling means for coupling to another of said plurality of repositories across a communications medium.

12. Claim 70 is substantially the same as the independent claims of the U.S. Patent No. 6,708,157, further they are broader than the patented claims of the U.S. Patent No. 6,708,157.

13. But they clearly include the current applications claimed limitations of claim 70-86 as well. These limitations include the creating steps, determination step, and granting step and associated processing system and server repository. However, it would have been obvious to a person of ordinary skill in the art to modify any of the claims 1-23 of U.S. Patent No. 6,708,157 by removing or combining certain limitations directed to the elements that make up a system resulting in a claim such as claims 70 of current application, since both claims actually perform the same function. It is well established that the omission or combination of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

1. Claims 87-102 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,715,403 to Mark J. Stefik.

2. As for claim 1 of U.S. Patent No. 5,715,403 recites:

- A grammar to create instances of usage rights
- Means for creating usage right
- A default plurality of conditions
- Means to associate the usage right with digital work
- Means to attach the usage right to digital work
- A requestor repository having means for generating usage transaction
- A server repository having means for processing usage transaction

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- Means to determine if access to digital work can be granted

3. Claim 1 of U.S. Patent No. 5,715,403 differs since it further recites additional claim limitations.

These limitations include the requesting repository and associated processing system and server repository and associated processing system. However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of U.S. Patent No. 5,715,403 by removing certain limitations directed to the elements that make up a system resulting in a claim such as claims 1, 22, and 42 of current application, since both claims actually perform the same function. It is well established that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

4. As for claims 88-102, the same rational as above exists. Even though the language of the claims are different the essence of invention claimed in the claims are the same and they deemed to be the same as claims 1-13.

5. As for claims 88-102 of the current application, they claim the same invention as the claims 1-13 of patent no. 5,715,403. Claims 1-13 of U.S. Patent No. 5,715,403, recite;

- Creation and association of digital rights based on a grammar.
- Having the means of changing the default plurality of conditions.
- Means to create instances of usage rights,
- Permitting creation of new digital work,
- Making a back up of the digital work,
- Concealing the digital work,
- Deleting the digital work.
- Digital work is a software
- Creating instances of usage rights,
- Installing or uninstalling the software,
- Identifying a revenue owner,
- Identifying a class of rendering devices,

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- Creating instances of usage rights such as having multiple conditions associated with multiple versions contained in the same first set of rights.

6. However, it would have been obvious to a person of ordinary skill in the art to modify claims 1-13 of patent no. 5,715,403 by removing certain limitations directed to elements that make up the system to achieve the same in claims 88-102 of the current application. As it is clear, the same inventive essence is claimed in the current application. Therefore, the claimed invention in claims 87-102 are deemed to be the same as claims 1-13 of patent no. 5,715,403.

14. The MPEP Further Notes:

The court in *Vogel* recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to court, one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court pointed out that "this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103 since only the disclosure of the invention claimed in the patent may be examined."

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 70-74, 76, 79, 82, 84-91, 93-95, 98-99, and 101-102 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,260,999 to Robert M. Wyman et al.

16. As per claim 70, Wyman discloses a digital work recorded on a computer readable media for use within a system having at least one repository for enforcing use of digital content in accordance with usage rights associated with the digital content, said digital work comprising:

- digital content electronically recorded on a first media portion and being capable of being rendered by a rendering engine (See figures 1-46 and associated text, column 1, lines 48-68,

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column 2, lines 1-15 and 53-63, column 4, lines 40-44, column 6, lines 49-67, and column 7, lines 3-28); and

- usage rights electronically recorded on a second media portion and being associated with said digital content (See Wyman figures 1-46 and associated text, column 6, lines 49-67, column 7, lines 3-28, column 11, lines 54-68, column 12, lines 1-4, column 16, lines 18-68, and column 17, lines 1-35);
- said usage rights specifying a manner of use by which a repository will permit use of the digital content (See Wyman abstract, figures 1-7 and associated text, column 6, lines 43-68, column 7, lines 1-68, column 8, lines 1-40, column 12, lines 1-59, column 13, lines 9-39, column 14, lines 1-61, column 16, lines 1-17, and column 17, lines 1-35);
- said usage rights including symbols selected from a set of predetermined symbols which define a valid sequence of symbols that are interpreted by the repository to indicate the manner of use (See Wyman abstract, figures 1-46 and associated text, column 13, lines 9-39, column 16, lines 1-17, column 33, lines 4-34, column 30, lines 30-68, and column 31, lines 38-63).

17. As per claim 71, Wyman discloses all the limitations of claim 70, further; wherein said usage rights also specify one or more conditions which must be satisfied before the manner of use may be exercised (See Wyman figures 1-46 and associated text, column 13, lines 9-39, column 16, lines 1-17, and column 33, lines 4-34).

18. As per claim 72, Wyman discloses all the limitations of claim 71, further; wherein said conditions include symbols selected from a set of predetermined symbols to define a valid sequence of symbols that are interpreted by the repository to indicate the conditions (See Wyman abstract, figures 1-46 and associated text, column 13, lines 9-39, column 16, lines 1-17, column 33, lines 4-34, column 30, lines 30-68, and column 31, lines 38-63).

19. As per claim 73, Wyman discloses all the limitations of claim 72, further;

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wherein the conditions include a set of default conditions (See Wyman abstract, figures 1-46 and associated text, column 19, lines 28-60, column 39, lines 59-66, and column 40, lines 35-40).

20. As per claim 74, Wyman discloses all the limitations of claim 70, further; wherein the manner of use specifies a manner by which an authorized party is able to render the digital content (See Wyman figures 1-46 and associated text, column 11, lines 3-16).

21. As per claim 76, Wyman discloses all the limitations of claim 70, further; wherein the manner of use specifies the manner by which an authorized party is able to make a back-up copy of the digital content (See Wyman figures 1-46 and associated text, column 40, lines 33-39).

22. As per claim 79, Wyman discloses all the limitations of claim 70, further; wherein the digital content is a software program (See Wyman figures 1-46 and associated text, abstract).

23. As per claim 82, Wyman discloses all the limitations of claim 70, further; wherein the usage rights comprise a revenue identifier for identifying a revenue owner of the digital work (See Wyman figures 1-46 and associated text, column 10, lines 40-50, column 19, lines 1-16, column 19, lines 61-68, and column 20, lines 1-4).

24. As per claim 84, Wyman discloses all the limitations of claim 70, further; wherein the symbols are codes (See Wyman figures 1-46 and associated text, column 12, lines 1-40, column 13, lines 9-18, column 15, lines 5-17, column 16, lines 9-35, and column 39, lines 67-68, column 38, lines 41-55).

25. As per claim 85, Wyman discloses all the limitations of claim 70, further;

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wherein the symbols are identifiers (See Wyman figures 1-46 and associated text, column 12, lines 1-40, column 13, lines 9-18, column 15, lines 5-17, column 16, lines 9-35, and column 39, lines 67-68, column 38, lines 41-55).

26. As per claim 86, Wyman discloses all the limitations of claim 70, further; wherein the symbols are parameters (See Wyman figures 1-46 and associated text, column 12, lines 1-40, column 13, lines 9-18, column 15, lines 5-17, column 16, lines 9-35, and column 39, lines 67-68, column 38, lines 41-55).

27. As per claim 87, Wyman discloses a grammar for creating usage rights for use within a system having at least one repository for enforcing use of digital content in accordance with usage rights associated with the digital content, said grammar comprising:

- a first set of predetermined computer readable symbols for defining a valid sequence of symbols recorded on a computer readable medium in association with the digital content and interpreted by a repository to indicate a manner of use by which a repository will permit use of the digital content (See Wyman figures 1-46 and associated text, column 6, lines 49-67, column 7, lines 3-28, column 10, lines 14-68, column 11, lines 1-30, column 12, lines 1-40, column 12, lines 1-60, and column 38, lines 41-55);
- whereby a repository can process a usage transaction specifying the computer readable symbols to determine if a requested use of the digital content can be permitted (See Wyman abstract, figures 1-7 and associated text, column 6, lines 43-68, column 7, lines 1-68, column 8, lines 1-40, column 12, lines 1-59, column 13, lines 9-39, column 14, lines 1-61, column 16, lines 1-17, and column 17, lines 1-35).

28. As per claim 88, Wyman discloses all the limitations of claim 87, further; a second set of predetermined symbols for defining a valid sequence of symbols that are interpreted by a repository to indicate one or more conditions which must be satisfied before the manner of use may be exercised (See Wyman abstract, figures 1-46 and associated text, column 13, lines 9-39, column 16, lines 1-17, column 33, lines 4-34, column 30, lines 30-68, and column 31, lines 38-63).

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29. As per claim 89, Wyman discloses all the limitations of claim 88, further; wherein said first set of predetermined symbols comprises a first set of grammar elements and said second set of predetermined symbols comprises a second set of grammar elements (See Wyman abstract, figures 1-46 and associated text, column 13, lines 9-39, column 16, lines 1-17, column 33, lines 4-34, column 30, lines 30-68, and column 31, lines 38-63).

30. As per claim 90, Wyman discloses all the limitations of claim 88, further; wherein said first set of grammar elements comprises a plurality of predetermined rights categories and predetermined values that can be assigned to said rights categories (See Wyman abstract, figures 8-46 and associated text, column 13, lines 9-39, column 16, lines 1-17, column 33, lines 4-34, column 30, lines 30-68, column 31, lines 38-63, and column 45, lines 10-30).

31. As per claim 91, Wyman discloses all the limitations of claim 89, further; wherein said second set of grammar elements comprises a plurality of predetermined condition categories and predetermined values that can be assigned to said condition categories (See Wyman figures 1-46 and associated text, column 19, lines 28-60, column 39, lines 59-66, and column 40, lines 35-40).

32. As per claim 93, Wyman discloses all the limitations of claim 91, further; wherein said condition categories comprise alternative categories (See Wyman abstract, figures 8-46 and associated text, column 13, lines 9-39, column 16, lines 1-17, column 33, lines 4-34, column 30, lines 30-68, column 31, lines 38-63, and column 45, lines 10-30).

33. As per claim 94, Wyman discloses all the limitations of claim 87, further; a third set of predetermined symbols for defining a valid sequence of symbols that are interpreted by a repository to indicate fees that must be paid to exercise the manner of use (See Wyman figures 1-46 and

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associated text, column 10, lines 40-50, column 19, lines 1-16, column 19, lines 61-68, and column 20, lines 1-4).

34. As per claim 95, Wyman discloses all the limitations of claim 94, further; wherein said third set of predetermined symbols comprises a third set of grammar elements (See Wyman abstract, figures 8-46 and associated text, column 13, lines 9-39, column 16, lines 1-17, column 33, lines 4-34, column 30, lines 30-68, column 31, lines 38-63, and column 45, lines 10-30).

35. As per claim 98, Wyman discloses all the limitations of claim 70, further; wherein the first media portion and the second media portion are parts of a same computer readable media (See Wyman figures 1-46 and associated text, column 6, lines 41-68, column 7, lines 1-3, column 10, lines 14-68, and column 11, lines 1-30).

36. As per claim 99, Wyman discloses all the limitations of claim 70, further; wherein the first media portion and the second media portion are parts of different computer readable media (See Wyman figures 1-46 and associated text, column 6, lines 41-68, column 7, lines 1-3, column 10, lines 14-68, and column 11, lines 1-30).

37. As per claim 101, Wyman discloses all the limitations of claim 70, further; wherein said content and said usage rights are stored on the same device (See Wyman figures 1-46 and associated text, column 6, lines 41-68, column 7, lines 1-3, column 10, lines 14-68, and column 11, lines 1-30).

38. As per claim 102, Wyman discloses all the limitations of claim 70, further; wherein said content and said usage rights are stored on different devices (See Wyman figures 1-46 and associated text, column 6, lines 41-68, column 7, lines 1-3, column 10, lines 14-68, and column 11, lines 1-30).

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39. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Claim Rejections - 35 USC § 103

40. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

41. Claims 96-97 and 100 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,260,999 Robert M. Wyman.

42. As per claims 96 and 97, Wyman discloses all the limitations of claim 95, further; Wyman clearly discloses that charging of fees and how it is attributed to the usage categories (See Wyman figures 1-46 and associated text, column 10, lines 40-50, column 19, lines 1-16, column 19, lines 61-68, and column 20, lines 1-4). But Wyman is clear on the elements comprises a plurality of predetermined fee categories but Wyman is not specific on predetermined values that can be assigned to said fee categories, and said fee categories comprise alternative categories. However, this type of class and subclass of usage and fee associated with the usage is well known in the art and has been used to charge the usage of software, games, digital pictures, etc. depending on the type of usage and extend of the usage. Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to add sub-categories to existing categories of fee related determinants to

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distinguish certain types of usage as it has been disclosed by Wyman to create a extend the efficiency of the process of fee assignments and collections.

43. As per claim 100, Wyman discloses all the limitations of claim 70, further; Wyman discloses that the content comprising a content file (See Wyman figure 2, column 11, lines 54-68). But Wyman is not specific on that said usage rights comprising a description tree file. However, examiner takes Official Notice that having a descriptive tree file (B tree file in Macintosh OS, directory or root file in Windows OS) to be included along with other files is old and well known in computer filing systems. Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have such directory or tree file stored along with the content to make access to the file and its attributes faster and more consistent.

44. Claims 75 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,260,999 Robert M. Wyman in view of U.S. Patent No. 5,138,712 to John R. Corbion.

45. As per claim 75, Wyman discloses all the limitations of claims 70, further; Wyman discloses the claimed invention, as discussed above, except for the step that an authorized party can use the digital work to create a new digital work. However, Corbin Clearly discloses a system for creating a new version of software. (See Corbin column 12, lines 6-54). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine Wyman 's teaching with that of Corbin teachings for creating new digital work (Such as a new version of software) as claimed because it could increase the processing capability of Wyman to adjust to specific requirements of the system.

46. As per claim 78, Wyman discloses all the limitations of claims 70, further; Wyman discloses the claimed invention, as discussed above, except for the step that an authorized party is able delete the corresponding digital work. However, Corbin clearly teaches the steps of deleting a

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digital work (See Corbin column 5, lines 18-28). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine Wyman 's teaching with that of Corbin teachings for improve the ability to manage the number of licenses available.

47. Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,260,999 Robert M. Wyman in view of U.S. Patent No. 5,255,106 to Peter D. Castro.

48. As per claim 77, Wyman discloses all the limitations of claims 70, further; Wyman does not discloses the manner by which an authorized party is able to conceal the corresponding digital work. However, Castro clearly discloses a system for concealing digital work (See Castro column 3, lines 20-26). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine both teachings because the use of Castro's teaching could enhance the processing of Wyman for adapting to different requirements of the licensing software system.

49. Claims 80, 81, and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,260,999 Robert M. Wyman in view of U.S. Patent No. 5,646,992 to Ronald J. Subler.

50. As per claims 80 and 81, Wyman discloses all the limitations as recited in claims 79, further; Wyman is not clear or explicit on the manner by which an authorized party is able to install and uninstall the software program. However, Subler is clearly teaches the installation and unstalling of digital works (Software) on the users system (See Subler column 12, lines 29-38 and column 14, lines 56-66). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the teachings of Wyman and Subler to create a system that clearly discloses the ability to install and remove an item from a system. This would be advantageous on the manner that user will have control over where the digital work is installed and when it is removed.

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51. As per claim 83, Wyman discloses all the limitations of claim 70, further;

Wyman is not clear or explicit on a class identifier for identifying a class of rendering devices upon which the digital work can be rendered on (See Wyman figure 1 and associated text, column 15, lines 5-17 and column 17, lines 49-68). However, Subler teaches that when a user wants to order a digital item from a plurality of items the system will check the compatibility of the item with the end user system to assure that they match (See Subler column 4, lines 65-68 and column 5, lines 1-4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two teachings to have a distribution control to prevent the incompatible digital work to be forwarded to the end users system.

52. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

54. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

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(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
June 28, 2004**



**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**